

REMARKS

Review and reconsideration of the final Office Action mailed September 4, 2009 (the "Office Action"), is respectfully requested in view of the preceding amendments and the following remarks. Although no fees are believed due, the Commissioner is hereby authorized to charge any deficiency or credit any surplus to Deposit Account No. 14-1437.

At the time of the Office Action, claims 1-15 were pending, with all claims being rejected under 35 U.S.C. §103 and 35 U.S.C. §112. By this Amendment, claims 1, 10, 11 and 15 are amended and claims 4, 13 and 14 are canceled. No new claims have been added. No new matter has been added.

The amendments presented herein have been made solely to expedite prosecution of the instant application to allowance and should not be construed as an indication of Applicants' agreement with or acquiescence to the Examiner's position. Accordingly, Applicants expressly maintain the right to pursue broader subject matter through subsequent amendments, continuation or divisional applications, reexamination or reissue proceedings, and all other available means. The rejections and responses thereto are set forth fully below.

Claim Objections

In the Office Action, claims 1, 10, 11 and 15 were objected to for not being in proper Markush format. Claims 1, 11 and 15 have been amended herein to no longer recite "selected from among..." Claim 10 has been amended herein to recite "selected from the group consisting of..." Claim 1 was objected to for grammatical errors. Claim 1 has been amended herein to correct the grammatical errors. Claims 13 and 14 were also objected to, and have been canceled herein.

Accordingly, Applicants respectfully request that the objections be withdrawn.

Claim Rejections – 35 U.S.C. § 112, First Paragraph

In the Office Action, claims 1-15 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. According to the Office Action, the instant specification does not provide support for “cosmetically acceptable glycol derivatives,” and thus instant claims 1, 11 and 15 introduce new matter. Applicants respectfully disagree with this rejection. However, in order to expedite prosecution, claims 1 (from which claims 2, 3, and 5-12 depend), 11 and 15 have been amended herein to no longer recite “cosmetically acceptable glycol derivatives.” Claims 4, 13 and 14 have been canceled.

Applicants have made appropriate amendments to claims 1, 11 and 15. Accordingly, Applicants respectfully request that the rejection of claims 1-3, 5-12 and 15 based on 35 U.S.C. §112, first paragraph, be withdrawn.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

In the Office Action, claims 1-15 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action asserts that the term “derivative” and the phrase “cosmetically acceptable glycol derivative” render the claims indefinite.

Applicants respectfully disagree with this rejection. However, in order to expedite prosecution, claims 1 (from which claims 2, 3, and 5-12 depend), 11 and 15 have been amended herein to no longer recite “cosmetically acceptable glycol derivatives.” Claims 4, 13 and 14 have been canceled.

Applicants have made appropriate amendments to claims 1, 11 and 15. Accordingly, Applicants respectfully request that the rejection of claims 1-3, 5-12 and 15 based on 35 U.S.C. §112, second paragraph, be withdrawn.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, claims 1, 2, 4-10 and 12-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,318,774 issued to Alban *et al.* (hereinafter “Alban”), as evidenced by U.S. Patent No. 4,873,078 issued to Edmundson (hereinafter “Edmundson”), the Free Online Medical Dictionary reference for q.s. accessed 1/30/2009 from <http://medical-dictionary.thefreedictionary.com/q.s>, and U.S. Patent No. 5,565,216 issued to Cowsar *et al.* (hereinafter “Cowsar”), in view of U.S. Patent No. 4,457,784 issued to Bernhard (hereinafter “Bernhard”), and further in view of U.S. Patent No. 5,571,503 issued to Mausner (hereinafter “Mausner”), U.S. Patent No. 5,207,998 issued to Robinson *et al.* (hereinafter “Robinson”) and U.S. Patent No. 6,074,652 issued to Ishiwatari *et al.* (hereinafter “Ishiwatari”); claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over the previously recited references, further in view of U.S. Patent Application Publication No. 2002/0085984 filed by DiGirolamo (hereinafter “DiGirolamo”); and claim 11 was rejected over the previously recited references, further in view of U.S. Patent No. 6,391,835 issued to Gott *et al.* (hereinafter “Gott”), U.S. Patent No. 5,013,763 issued to Tubesing *et al.* (hereinafter “Tubesing”), U.S. Patent No. 5,126,136 issued to Merat *et al.* (hereinafter “Merat”), U.S. Patent No. 6,033,648 issued to Candau (hereinafter “Candau”), and U.S. Patent No. 6,296,860 issued to Hasegawa *et al.* (hereinafter “Hasegawa”).

The combination of Alban, Edmundson, the Free Online Dictionary, Cowsar, Bernhard, Mausner, Robinson, and Ishiwatari does not render claims 1, 2, 4-10 and 12-15 obvious within the meaning of 35 U.S.C. 103 because the combination of references fails to teach or suggest all claim limitations, the combination of references fails to suggest modifying their teachings to arrive at Applicants’ invention, and the results of the claimed combination were unexpected. As amended, the water-proof mascara composition of claims 1 and 15 are drawn to:

1. (Currently amended) A water-proof mascara composition which comprises

- a) an oil phase comprising a liquid ester, an oil or a mixture thereof, 1 to 50% by weight of a silicon-based film-forming agent, 0.1 to 10% by weight of a gel-forming agent being a mixture of glyceryl behenate and stearyl behenate in a ratio of 1:2 to 1:4 selected from among fatty acids, fatty acid esters, cosmetically useful glycol derivatives and mixtures thereof;
- b) 7 to 15 % by weight of pigments, ~~powders with~~ powders with [[a]] pigment like effects pigment-like effect, [[and]] or mixtures thereof;
- c) a water phase comprising 42 to 75% by weight of water;
- d) 0.1 to 10% by weight of a surface-active agent; and
- e) further carrier substances, auxiliaries, active agents or mixtures thereof, all percentages being relative to the total weight of the composition, wherein the composition is free of waxes and hydrocarbon solvents, wherein said water-proof mascara composition comprises an emulsion, and wherein the applied water-proof mascara composition exhibits no statistically increased amount of streaking, smudging or flaking after immersion in water.

15. (Currently Amended) A water-proof mascara composition which comprises

- a) an oil phase comprising a liquid ester, an oil or a mixture thereof, 15 to 30% by weight of a silicon-based film-forming agent, 0.1 to 10% by weight of a gel-forming agent being a mixture of glyceryl behenate and stearyl behenate in a ratio of 1:2 to 1:4 selected from among fatty acids, fatty acid esters, cosmetically useful glycol derivatives and mixtures thereof;
- b) 1 to 50% by weight of substances selected from [[among]] the group consisting of: pigments, powders, fillers and mixtures thereof;
- c) a water phase comprising 42 to 75% by weight of water;
- d) 0.1 to 10% by weight of a surface-active agent; and
- e) further carrier substances, auxiliaries, active agents or mixtures thereof, all percentages being relative to the total weight of the composition, wherein the composition is free of waxes and hydrocarbon solvents, wherein said water-proof mascara composition comprises an emulsion.

Of particular interest, the claimed water-proof mascara composition is a highly balanced emulsion that provides advantages over known water-proof mascara compositions, and that exhibits several surprising features, at least in part due to a special gel-forming agent that is a mixture of glyceryl behenate and stearyl behenate in a particular ratio of 1:2 to 1:4. Specification, Paragraph [00016]. For example, the claimed water-proof mascara compositions have surprisingly high water and pigment contents. Another surprising feature and advantage of the presently claimed water-proof mascara compositions is that they do not contain any waxes and hydrocarbons. Thus, the emulsion can be prepared by moderate heating (Specification, Paragraph [0008]) and special packaging is not needed. Specification, Paragraph [00038]. In addition, although the claimed water-proof mascara composition includes no hydrocarbon solvents or waxes, and includes a large amount of water, i.e., 42 to 75 wt-%, the claimed water-proof mascara exhibits no increased streaking, smudging or flaking when applied to eyelashes and immersed in water. This is an extremely unexpected result considering that water-proof mascara compositions typically require a substantial amount of hydrocarbon solvents and/or waxes, and little or no water in order to be water-proof. Specification, Paragraph [0034]. Surprisingly, the claimed water-proof mascara can be washed off with warm water. Specification, Paragraph [00035].

Applicants note that the claimed water-proof mascara does not include any waxes or hydrocarbon solvents, but includes 42-75 wt-% water. Because of this, it is very surprising that the claimed compositions form a stable water-proof mascara, as wax levels up to 20% are generally needed to get a stable water-proof mascara and because water-proof cosmetic compositions generally include waxes and hydrocarbon solvents. None of the cited references, nor combination thereof, mention mascara, and therefore do not address the specific problems related to water-proof mascara in general, including formation of stable films, water resistance, abrasion resistance, homogenous distribution of pigments, etc. Because the cited references do not mention mascara, they provide absolutely no motivation to formulate a water-proof mascara

composition that is free of waxes and hydrocarbon solvents. The absence of waxes and hydrocarbon solvents is a surprising and inventive feature of the claimed invention. In contrast to the teachings of the prior art and surprisingly, in view of the conventional wisdom at the time the application was filed, the claimed water-proof mascara produces a stable aqueous gel using the silicone-based film forming agents and other claimed ingredients in the claimed amounts. The claimed water-proof mascara is highly balanced and was developed only after an unexpected result occurred after extensive experimentation. This balance of ingredients is neither disclosed nor suggested by the cited references nor the combination thereof.

The inclusion of pigments in aqueous cosmetic compositions is very difficult because pigments are hydrophobic and thus need a hydrophobic solvent. Specification, Paragraph [0036]. In addition, it is well known that pigments are known to exhibit emulsion breaking properties. Surprisingly, the mascara of the present invention includes a large amount of pigments, preferably 7 to 15 wt-% of pigments. Specification, Paragraph [00020]. This is yet another unexpected result achieved by the careful balancing of ingredients developed by Applicants while developing the claimed water-proof mascara. As explained previously, Applicants have unexpectedly been able to formulate water-proof mascara compositions with such high amounts of pigments by using the particular claimed amounts of the particular claimed ingredients.

Applicants note that none of the cited references used to reject claims 1-10, and 12-15 disclose a mascara composition. Since none of the cited references is drawn to a mascara composition, any optimization of any ingredient would be to produce an improved lotion, for example, not the claimed water-proof mascara compositions. The cited references belong to different fields of the cosmetic industry, such as skin lotions, sunscreens, hair shampoos, hair relaxing compositions, lipsticks and so on. In particular, the primary reference, Alban, is drawn to a lotion for imparting an artificial tan to human skin. Alban, Abstract. Applicants maintain that one of skill in the art would not be motivated or led to modify the lotions of Albans or any of

the other cited references to arrive at a water-proof mascara, and that modifying the skin tanning lotion of Albans to form a water-proof mascara would render Albans unsatisfactory for its intended purpose¹. As modifying Alban's skin lotion to have the properties of a mascara would render the skin lotion unsatisfactory for its intended use, Applicants respectfully submit that the modifications suggested in the Office Action cannot establish a *prima facie* case of obviousness against the amended claims.

Applicants also note that none of the cited documents disclose or even suggest the claimed limitation of a gel-forming agent that is a mixture of glyceryl behenate and stearyl behenate at a ratio of 1:2 to 1:4. The special gel-forming agent of the present invention was specifically chosen based on Applicants' extensive experimentation. Due to the special gel-forming agent as presently claimed, the water-proof mascara shows a high viscosity although high contents of film-forming agents are incorporated (Specification, Paragraph [00013]) which are needed to achieve the improved brilliance compared to known compositions (Specification, Paragraph [00037]). The special gelling agent is further needed to stabilize the high content of pigments and to stabilize the emulsion. In summary, the water-proof mascara of the present invention shows many advantages and surprising features which are at least partly based on the special gelling agent.

Turning back to Alban, this reference discloses a skin tanning lotion that comprises dihydroxyacetone (DHA) and at least one alkyl hydroxyalkylcellulose or a derivative thereof. Neither DHA nor alkyl hydroxyalkylcellulose or derivatives thereof are typically found in mascara compositions. Thus, Alban is not suitable for a mascara composition.

The Office Action asserts that fatty acid esters, such as glyceryl esters are used in Alban's tanning compositions. However, Alban notes that it is important that the fatty acid esters and

¹ If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01.V.

hydroxyalkylcellulose are present in a proper weight ratio (col. 6, lines 26 - 36). Thus, the skilled person is not motivated by Alban to use fatty acid esters alone, as in the claimed water-proof mascara composition.

Applicants respectfully submit that a person of skill in the art would understand that body lotions, such as the tanning compositions disclosed in Alban, contain a high water-content. In contrast, water-proof mascaras usually contain hydrocarbons and no or only small amounts of water. Thus, it is very surprising that the claimed composition can include 42-75 wt-% of water and form a water-proof mascara that is a stable emulsion without using any waxes or hydrocarbons.

Combining Alban with the seven other cited references does not remedy the deficiencies of Alban, and for the reasons cited above, one aware of the combination of eight references would not be led or motivated to modify the combination to arrive at a water-proof mascara.

With respect to the arguments in the Office Action that the claimed mascara properties are merely an intended use, in *In re Chupp* (*In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987)) the Federal Circuit clearly uses evidence that a composition of matter exhibits unexpectedly improved herbicidal activity with respect to two plant varieties as evidence sufficient to overcome an obviousness rejection. Clearly, the Federal Circuit precedent does not support a conclusion that intrinsic properties of a claimed composition, such as the water-proof mascara properties of the claimed cosmetic composition, are merely intended use limitations that are not entitled to patentable weight.

The unexpected properties (a waterproof mascara that is a stable emulsion containing 7-15 wt-% pigment and a gel-forming agent that is a mixture of glyceryl behenate and stearyl behenate in a ratio of 1:2 to 1:4, and lack of streaking, flaking and smudging when applied to eyelashes and immersed in water) of the claimed composition are neither disclosed nor suggested by the cited references. As explained by *In re Rijckaert*, 9 F.2d 1531, 1534 (Fed. Cir. 1993), "Obviousness cannot be predicated on what is not known at the time an invention is made, even

if the inherency of a certain feature is later established." *See* MPEP 2141.02.V. In addition, the Federal Circuit in *In re Chupp* concluded that the fact that a compound or composition possesses superior and unexpected properties in one of a spectrum of common properties was sufficient to rebut a *prima facie* case of obviousness. *See In re Chupp*, 816 F.2d at 646. Thus, a conclusion of obviousness cannot be supported considering the fact that there is nothing in the cited references that discloses or suggests the claimed water-proof mascara compositions that are stable emulsions containing 7-15 wt-% pigment and a gel-forming agent that is a mixture of glyceryl behenate and stearyl behenate in a ratio of 1:2 to 1:4, and that exhibit a lack of streaking, flaking and smudging when applied to eyelashes and then immersed in water. Accordingly, Applicants respectfully submit that all claims are drawn to patentable subject matter.

In summary, Applicants reiterate that Alban is not drawn to a water-proof mascara and there would be no motivation to modify Alban to produce a water-proof mascara because the necessary modifications would render Alban unsatisfactory for its intended use, i.e., as a skin tanning lotion. MPEP 2143.01.V. Furthermore, the other cited references are drawn to cosmetic compositions that have nothing to do with the claimed water-proof mascara. In addition, the majority of the cited references are drawn to cosmetics that include waxes and/or hydrocarbons. Also, there is nothing in the cited references to disclose or suggest a water-proof mascara, or the desirability of producing a water-proof mascara that is free of waxes and hydrocarbons. Finally, the claimed combination yielded unexpected results.

Regarding the rejection of claims 3 and 11, all pending claims as amended herein are patentable over the remaining references (i.e., DiGirolamo, Gott, Tubesing, Merat, Candau, Hasegawa) when combined with Alban, Edmundson, the Free Online Medical Dictionary, Cowsar, Bernhard, Mausner, Ronbinson, and Ishiwatari because (1) the combinations do not teach or suggest all the claim limitations, e.g., a waterproof mascara that is a stable emulsion having 7 to 15% by weight of pigments, and a gel-forming agent that is a mixture of glyceryl behenate and stearyl behenate in a ratio of 1:2 to 1:4; and (2) the results of the claimed invention

were unexpected.

For at least the reasons described above, Applicants respectfully submit that the claimed combination yielded unexpected results, that the combinations of references fail to suggest modifying their teachings to arrive at Applicants' invention, and that the cited references and combinations thereof fail to disclose or suggest all limitations of the claimed water-proof mascara set forth in amended claims 1, 11 and 15. Even if the cited combinations of references disclosed every limitation of the claims, Applicants respectfully submit that the unexpected results provided by the claimed invention is sufficient to overcome obviousness in accordance with MPEP § 2145.

Accordingly, Applicants respectfully request that these rejections be withdrawn.

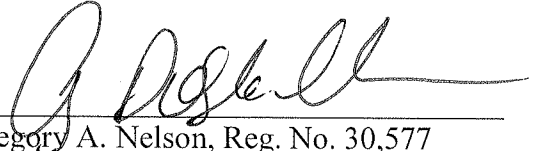
Conclusion

For at least the reasons set forth above, the independent claims are believed to be allowable. In addition, the dependent claims are believed to be allowable due to their dependence on an allowable base claim and for further features recited therein. The application is believed to be in condition for immediate allowance. If any issues remain outstanding, Applicant invites the Examiner to call the undersigned if it is believed that a telephone interview would expedite the prosecution of the application to an allowance.

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Amendment B
Attorney Docket: 3975-041
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Respectfully submitted,

NOVAK DRUCE + QUIGG LLP

A handwritten signature in black ink, appearing to read 'G. Nelson', written over a horizontal line.

Date: October 27, 2009

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